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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/668,100

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Shelton L. Palmer

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SIDLEY AUSTIN LLP

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1501 K STREET NW

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EXAMINER

LAZARO, DAVID R

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/668,100	<b>Applicant(s)</b> PALMER ET AL.	
	<b>Examiner</b> DAVID LAZARO	<b>Art Unit</b> 2455	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 42-48 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 42-48 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 March 0922 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/25/04</u> .  | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION**

1. Claims 1-41 are canceled.
2. Claims 42-48 are pending in this office action.

***Priority***

3. This application is a reissue of 08/739796 and a division of 09/860259.

***Information Disclosure Statement***

4. The information disclosure statement (IDS) submitted on 10/25/04 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

***Reissue Applications***

5. The reissue oath/declaration filed with this application is defective because it fails to identify at least one error which is relied upon to support the reissue application. See 37 CFR 1.175(a)(1) and MPEP § 1414.
6. The identified error in the oath submitted 09/22/03 is one related to a matter of recapture of broadened claimed subject matter surrender in the application for patent upon which the present reissues is based. This error is improper and therefore, applicant's declaration remains defective until a proper error is identified.

***Rejection under 35 § USC 251***

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## 7. 35 U.S.C. 251 Reissue of defective patents.

Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Director shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent. No new matter shall be introduced into the application for reissue. The Director may issue several reissued patents for distinct and separate parts of the thing patented, upon demand of the applicant, and upon payment of the required fee for a reissue for each of such reissued patents. The provisions of this title relating to applications for patent shall be applicable to applications for reissue of a patent, except that application for reissue may be made and sworn to by the assignee of the entire interest if the application does not seek to enlarge the scope of the claims of the original patent. No reissued patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent.

*Improper Recapture*

8. Applicants are reminded that a "reissue will not be granted to 'recapture' claimed subject matter which was surrendered in an application to obtain the original patent."

(See MPEP §1412.02). The MPEP states, "If the limitation now being omitted or broadened in the present reissue was originally presented/argued/stated in the original-application to make the claims allowable over a rejection or objection made in the original application, the omitted limitation relates to subject matter previously surrendered by applicant, and impermissible recapture exists."

9. Claims 42-48 are rejected under 35 U.S.C. § 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See Hester Industries, Inc. v. Stein, Inc., 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); In re Clement, 131 F.3d 1464, 45 USPQ2d

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1161 (Fed. Cir. 1997); Ball Corp. v. United States, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue, which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application

10. The summary of the prosecution history of the parent application 08/739796 is as follows:

(A) In Paper No. 7 of the parent patent application, pages 6-7, applicants discuss the Examiner's rejection of claims 1-26 under 35 U.S.C. § 112, second paragraph, because the steps of broadcasting, transmitting, and receiving in claims 1-26 are unclear about from where such steps are occurring.

Accordingly, the applicants amended the independent claims in order to address the Examiner's rejection by clarifying from where the steps of broadcasting, transmitting, and receiving occurred and clarifying steps in the independent claims.

(B) Additionally, the applicants agreed to re-write all independent claims in more detail by adding 'receiving', and 'coordinating', steps in order to put the all independent claims in better position for allowance (see interview summary, Paper No. 9).

(C) The applicants set forth remarks in Paper No. 8 of the parent patent application, page 8, that the Examiner and the applicant had discussed the language of the pending claims in the context of compliance with 35 U.S.C. § 112. As a result of such discussion, the claims were amended to address the Examiner's 35 U.S.C. § 112 concerns and for clarification purposes.

11. For the reasons set forth above (A-C) the applicants amended the claims to more clearly define the invention so as to overcome the 35 U.S.C. §112 second paragraph rejection. The claims in the reissue application are broadened in relation to the 'receiving' and 'coordinating' steps (discussed in (B) above) as follows:

a. Claims 42-48 omits subject matter regarding both "receiving an address identifying the data service at an address transmitter" and "coordinating said step of transmitting to occur simultaneously with said step of broadcasting"

Note: The examiner does take into consideration broader forms of these key limitations in evaluating the claims.

12. Therefore, because claims 139-164 were broadened in relation to surrendered subject matter, and consideration was given to broader forms of this subject matter (i.e., consideration as to whether reissued claims were materially narrowed in other respect to avoid recapture rule), there is improper recapture.

13. Furthermore, On page 26 of the remarks filed 05/28/2002 in the parent application 09/860259, applicant indicates surrendered subject matter in the application for the patent upon which the present reissue is based by stating,

*"In paper 7 of the prosecution history, the Applicant's only amendments made in response to prior art rejections related to adding the phrases to the claims:*

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*"independent of user interaction with said on-line service" and  
"automatically accessing said on-line service by said computer using said  
address identifying said on-line service"*

14. Claims 42-48 present a broadening aspect that is related to this subject matter that applicant previously surrendered during the prosecution of the application for the patent upon which the present reissue is based.

15. Particularly, the broadening aspects are as follows:

b. Claims 42-48 do not include either "independent of user interaction with said on-line service" or "automatically accessing said on-line service by said computer using said address identifying said on-line service"

Note: The examiner does take into consideration broader forms of these key limitations in evaluating the claims.

16. Therefore, because claims 42-48 were broadened in relation to surrendered subject matter, and consideration was given to broader forms of this subject matter (i.e., consideration as to whether reissued claims were materially narrowed in other respect to avoid recapture rule), there is improper recapture.

### ***Claim Rejections - 35 USC § 112***

17. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

18. Claims 46-48 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which

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was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

19. Claim 46 is directed towards a method of obtaining profiling data. This includes steps related to transmitting an internet address which specifies a web site corresponding to programming and containing information requiring a response from user. The responses are then used to obtain a profile of users. However, the specification does not describe such subject matter. While a profile is discussed in Col. 7, lines 27-45, of the specification (cited based on 5,905,865), there is no indication of the specific details described by claimed subject matter for obtaining the profile. Col. 7, lines 27-45, only generically states, "the user may complete a profile indicating certain preferences". There is no indication of the profile being obtained from a web site that corresponds to a programming, is retrieved based on a transmitted internet address, and contains information requiring responses specific to the task of obtaining a profile of users. As such, claim 46 and its dependents fail to comply with the written description requirement.

20. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

21. Claims 42-48 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.



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22. Claim 42 uses the language “the broadcast programming **being selectively** a television broadcast program”. It is not entirely clear as to what meaning applicant intends such language to impart on the scope of the claimed subject. The word “selectively” implies choice. As such, it appears the scope of the claim only states that the broadcast **may** be a television broadcast program, but it is not a requirement of the claim. As it is not clear as to what applicant intends, the examiner will use this interpretation that the broadcast “may” be a television broadcast. This applies to dependent claims 43-45.

23. Claim 46 uses the language “a broadcast programming, **selectively** a television broadcast program”. It is not entirely clear as to what meaning applicant intends such language to impart on the scope of the claimed subject. The word “selectively” implies choice. As such, it appears the scope of the claim only states that the broadcast **may** be a television broadcast program, but it is not a requirement of the claim. As it is not clear as to what applicant intends, the examiner will use this interpretation that the broadcast “may” be a television broadcast. This applies to dependent claims 47-48.

### ***Claim Rejections - 35 USC § 101***

24. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

25. Claims 42-48 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

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26. Claims 42-45 are directed towards a method for providing education. A statutory “process” under 35 U.S.C. 101 must (1) be tied to particular machine, or (2) transform underlying subject matter (such as an article or material) to a different state or thing. See page 10 of *In Re Bilski* 88 USPQ2d 1385. The instant claims are neither positively tied to a particular machine that accomplishes the claimed method steps nor transform underlying subject matter, and therefore do not qualify as a statutory process. The claim should positively recite the other statutory class to which it is tied, for example, by identifying the apparatus that accomplishes the method steps.

27. Claims 46-48 are directed towards a method for obtaining profiling data. A statutory “process” under 35 U.S.C. 101 must (1) be tied to particular machine, or (2) transform underlying subject matter (such as an article or material) to a different state or thing. See page 10 of *In Re Bilski* 88 USPQ2d 1385. The instant claims are neither positively tied to a particular machine that accomplishes the claimed method steps nor transform underlying subject matter, and therefore do not qualify as a statutory process. The claim should positively recite the other statutory class to which it is tied, for example, by identifying the apparatus that accomplishes the method steps.

### ***Claim Rejections - 35 USC § 103***

28. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

29. Claims 42-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,818,441 by Throckmorton et al. (Throckmorton) in view of Pitkow et al., "Using the Web as a survey tool: results from the second WWW user survey" Journal of Computer Networks and ISDN systems, vol. 27, 1995, pp.809-822 (12 pages) (hereinafter Pitkow).

30. With respect to claim 42, Throckmorton teaches a method of providing education comprising the steps of:

- a) receiving broadcast programming, the broadcast programming containing programming, and the broadcast programming being selectively a television broadcast program (Col. 3 lines 36-54, Col. 4 lines 1-33: primary stream transmitted and received can include broadcast programming, including television);

- b) receiving a transmitted Internet address, wherein the Internet address specifies a web site corresponding to the programming (Col. 3 lines 55 - Col. 4 line 33 and Col. 9 lines 1-15: associated data received can include an Internet address specifying a site. Associated data contains content corresponding to the programming);

- c) retrieving the website (Col. 9 lines 1-14 system connects to and retrieves site);

and

- d) displaying the web site (Col. 9 lines 1-14 system connects to and retrieves site)

While Throckmorton teaches the associated data of a primary stream contains content corresponding to the primary data and that the associated may take the form of a web site, Throckmorton only describes the associated content generically as

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ultimately the content used is up to the user when implementing/implement the invention. As such, Throckmorton does not describe an exhaustive list of what the web sites may contain. Particularly, Throckmorton does not explicitly disclose the web site as containing questions. Pitkow shows that a web site is an advantageous method for providing questions in reference to a particular topic (pages 2-5, Fig. 1, "Overview" and "Architecture" survey home page provides access to sets of questions and provides advantages over other forms of surveys).

It would have been obvious to one of ordinary skill in the art to have the corresponding content of Throckmorton be questions as shown in Pitkow.

Throckmorton clearly intends any form of associated data to be used and recognizes the advantages of online/Internet formats of data. Using the known form of providing content as a web site containing questions in providing associated data to a user in Throckmorton would have been obvious to one of ordinary skill in the art.

31. With respect to claim 43, Throckmorton teaches a method as claimed in claim 42, wherein the internet address is directly transmitted separately from the broadcast (Col. 4 lines 1-20).

32. With respect to claim 44, Throckmorton teaches a method as claimed in claim 42, wherein the website is displayed in relative synchronicity with the programming (Col. 3 lines 55-59 and Col. 7 line 53 - Col. 8 line3)

33. With respect to claim 45, Throckmorton teaches the method of claim 42 wherein the web site corresponding to the programming offers information about a question in

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the programming to the user (Col. 3 lines 55-67: associated data provides information relevant to any content of primary data).

34. With respect to claim 46, Throckmorton a method of obtaining profiling data comprising the steps of:

a) transmitting a broadcast programming, selectively a television broadcast (Col. 3 lines 36-54, Col. 4 lines 1-33: primary stream transmitted and received can include broadcast programming, including television);

b) transmitting an Internet address, wherein the Internet address specifies a web site corresponding to the programming (Col. 3 lines 55 - Col. 4 line 33 and Col. 9 lines 1-15: associated data received can include an Internet address specifying a site.

Associated data contains content corresponding to the programming);

c) permitting retrieval of the website by a user (Col. 9 lines 1-14 system connects to and retrieves site);

d) permitting display of the web site corresponding with the programming (Col. 9 lines 1-14 system connects to and retrieves site). whereby the web site contains information requiring a response from a user; and

e) collecting and summarizing responses from users thereby to obtain a profile of users and their responses.

While Throckmorton teaches the associated data of a primary stream contains content corresponding to the primary data and that the associated may take the form of a web site, Throckmorton only describes the associated content generically as ultimately the content used is up to the user when implementing/using the invention. As

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such, Throckmorton does not describe an exhaustive list of what the web sites may contain. Particularly, Throckmorton does not explicitly disclose the web site contains information requiring a response from a user; and collecting and summarizing responses from users thereby to obtain a profile of users and their responses. Pitkow shows that a web site is an advantageous method for providing questions in reference to a particular topic (pages 2-5, Fig. 1, "Overview" and "Architecture" survey home page provides access to sets of questions and provides advantages over other forms of surveys). Pitkow further shows that responses from the users and be collected and summarized to obtain a profile of users and their responses (Pages. 6-12 - Results-Conclusion and Appendix)

It would have been obvious to one of ordinary skill in the art to have the corresponding content of Throckmorton be questions and to obtain a profile of users and responses as shown in Pitkow. Throckmorton clearly intends any form of associated data to be used and recognizes the advantages of online/Internet formats of data. Using the known form of providing content as a web site containing information requiring responses in providing associated data to a user in Throckmorton would have been obvious to one of ordinary skill in the art.

35. With respect to claim 47, Throckmorton teaches a method as claimed in claim 46 wherein the internet address is directly transmitted separately from the broadcast (Col. 4 lines 1-20).

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36. With respect to claim 48, Throckmorton teaches a method as claimed in claim 46 wherein the website is displayed in relative synchronicity with the programming (Col. 3 lines 55-59 and Col. 7 line 53 - Col. 8 line3).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DAVID LAZARO whose telephone number is (571)272-3986. The examiner can normally be reached on 8:30-5:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar can be reached on 571-272-4006. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/David Lazaro/  
Primary Examiner, Art Unit 2455  
03/28/09